

TDW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 10/625,542

Filed: November 16, 2004

In re Application of

Group Art Unit: 2652

M. WATANABE et al

Examiner: R. Tupper

For: DISK DEVICE

PETITION TO DIRECTOR OF USPTO
UNDER 37 C.F.R. 1.181--1.183
TO RESTORE APPLICATION TO PENDING STATUS,
AND ISSUE PATENT THEREFROM

US Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants, by their undersigned attorneys, hereby petition the Director under 37 C.F.R. § 1.181—1.183 promptly to restore the above-identified application to pending status, and thereafter immediately issue a U.S. patent therefrom.

The following narrative of facts demonstrates why this application was never intended to have been abandoned and became abandoned through no fault of applicants, and should immediately be restored to pending status and issued as a U.S. patent:

BEST AVAILABLE COPY

Serial No. 10/625,542
Docket No. 28951.5236 D1

1. On November 22, 2004 an Amendment was filed herein from the former firm of applicants' undersigned attorney.

2. On March 22, 2005, a "Status Inquiry Letter" was filed in the USPTO from the former firm of applicants' undersigned attorney. Applicants' undersigned attorney's file of this application does not show that any response from the USPTO to that March 22, 2005 letter was ever received.

3. Effective April 1, 2005, applicants's undersigned attorney moved his practice from the former firm, Parkhurst & Wendel, LLP, 1421 Prince Street, Suite 210, Alexandria, Virginia 22314, to Steptoe & Johnson LLP, Washington, DC. Applicants' undersigned attorney established with the United States Postal Service a post office box having the address Parkhurst & Wendel LLP, P.O. Box 20249, Alexandria, VA 22320-1249, to which all mail addressed to the former 1421 Prince Street address was to be forwarded by the United States Postal Service.

4. On May 19, 2005 the USPTO apparently mailed a Notice of Allowance (PTOL-85) [Exhibit A, attached] along with a Notice of Allowability (PTOL-37), both of which were addressed to the 1421 Prince Street address. Those documents were apparently mailed from the USPTO in an envelope [Exhibit B] which was returned to the USPTO, received by the USPTO Mail Center on May 24, 2005 and bearing a sticker dated 05/21/05 indicating the aforementioned new P.O. Box 20249 address. See Exhibit B. The Exhibit B document was obtained from the online available copy of the

Serial No. 10/625,542
Docket No. 28951.5236 D1

prosecution history of the above-identified application. It thus appears that the United States Postal Service failed to follow the standing order of applicants' undersigned attorney to forward mail to the aforementioned P.O. Box.

5. It then appears that the USPTO re-mailed the Notice of Allowability and the 05/19/2005 Notice of Allowance (PTOL-85), but re-mailed them under a new communication cover sheet, which communication cover sheet bore applicants' attorneys' aforementioned P.O. Box 20249, Alexandria, Virginia address [Exhibit C]. Those documents were apparently duly received at that post office box and were brought to Steptoe & Johnson LLP, as evidenced by a "Received Nov 09 2005 Steptoe & Johnson LLP" date stamp appearing on the face of the 11/03/2005 communication cover sheet and on the Notice of Allowance (PTOL-85) [See again Exhibit C]. Applicants' attorneys' receipt of the communications mailed from the USPTO on November 3, 2005 was their first notice of the allowance of the above-identified application. The date for issue and publication fees due was thus docketed as February 3, 2006, three months from that 11/03/2005 mailing date.

6. The USPTO's internal records [Exhibit D] show that on November 28, 2005 there was a rush message from the printer stating "In response to returned NOA only a PTOL-37 was mailed out. Please mail out a new PTOL-85." A responsive message from the Examiner on 12/08/05 stated "no Examiner action required. A PTOL-85 was re-mailed," to which a second request from the printer was made on 12/30/05,

Serial No. 10/625,542
Docket No. 28951.5236 D1

stating “In response to returned NOA only a PTOL-37 was mailed out. Please mail out a new PTOL-85. What was received 12/08/05 was the old PTOL-85 (fee is late without new NOA).” These Exhibit D messages demonstrate that the PTO itself recognized that the copy of the May 19, 2005 Notice of Allowance with its date unchanged, re-mailed on November 3, 2005 was ineffective because the three-month response period commencing May 19, 2005 had already expired. It is thus clear that the USPTO in its 11/03/2005 communication intended to re-start the period for response to the Notice of Allowance.

7. Meanwhile, on December 8, 2005 applicants’ undersigned attorneys paid the Issue and Publication Fees due, and at the same time, filed a Notice of Change of Correspondence Address, all of which is acknowledged by applicants’ attorneys’ return receipt card [Exhibit E].

8. Then, on February 1, 2006 applicants’ undersigned attorneys received a communication mailed from the USPTO on 01/30/2006 constituting a “Notice of Abandonment” for alleged failure to timely pay the required issue fee and publication fees which were admittedly “received on 12/08/05” after expiration of the three-month period for payment of the issue fee set in the 5/19/2006 Notice of Allowance (PTOL-85) [Exhibit F]. It thus appears to be the position of the PTO as of January 30, 2006 that despite the fact that the PTO had knowledge that the Notice of Allowance mailed May 19, 2006 never reached applicants’ attorney until after it was re-mailed on November 3, 2006, that the returned May 19, 2006 mailing was nevertheless effective to start the

Serial No. 10/625,542
Docket No. 28951.5236 D1

running of a time period against applicants. This position is illogical and unfair in the circumstances of this case.

9. On February 3, 2006, applicants' undersigned attorneys filed a "Request for Rescission of Notice of Abandonment" [Exhibit G, attached]. That Request succinctly stated several of the key facts which are re-stated, in more detail, in this Petition. To date, that Request has been completely ignored by the PTO.

10. On January 11, 2007, applicants' attorneys discovered that the USPTO PAIR "Transaction History" not only shows no PTO action on the aforementioned Request filed February 3, 2006, but also lists a 07/24/2006 "mail abandonment for failure to pay issue fee." To date no such document has ever been received by applicants' undersigned attorneys.

11. It is apparent from the foregoing record that as early as May 25, 2005, the USPTO had actual knowledge that the Notice of Allowance "mailed" May 19, 2005 had not reached applicants' attorneys. When the PTO took action to re-mail the Notice of Allowance on November 3, 2005, the PTO failed to re-date the Notice of Allowance. Thus applicants' efforts remain completely unsatisfied as a result of the errors by the U.S. Postal Service and the USPTO that failed to result in receipt by applicants' attorneys of any Notice of Allowance until November 9, 2005, and the notice then received was already stale.

Serial No. 10/625,542
Docket No. 28951.5236 D1

In these circumstances, applicants respectfully petition and request the Director to waive any contrary rules, restore this application to pending status, and immediately, upon restoration thereof to pending status, apply the issue and publication fees already received by the PTO, and issue the patent to which applicants are entitled from this long-ago allowed application.

The foregoing facts are stated upon the actual knowledge, or information and belief, of applicants' undersigned attorney, and are all believed to be true.

The PTO is hereby authorized to charge/credit the petition fee prescribed by 37 C.F.R. §1.17(f) and/or any other applicable fees to applicants' attorneys' Deposit Account 19-4293. And, in the circumstances of this case, applicants hereby respectfully request that no such fees be charged for this Petition, or if initially charged that any such charged fees be refunded upon grant of this Petition.

Serial No. 10/625,542
Docket No. 28951.5236 D1

Should anyone at the USPTO have any question concerning this Petition, they are invited to telephone applicants' undersigned attorney at the number listed below.

Respectfully submitted,

STEPTOE & JOHNSON

A handwritten signature in black ink, appearing to read "Roger W. Parkhurst", written over the printed name.

Roger W. Parkhurst,
Reg. No. 25,177

Date: January 24, 2007

STEPTOE & JOHNSON LLP
1330 Connecticut Avenue, NW
Washington, DC 20036
Tel: 202-429-3000
Fax: 202-429-3902

Attachments: Exhibits A-G



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

6160 7590 05/19/2005
PARKHURST & WENDEL, L.L.P.
1421 PRINCE STREET
SUITE 210
ALEXANDRIA, VA 22314-2805

EXAMINER

TUPPER, ROBERT S

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 05/19/2005

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,542	07/24/2003	Masashi Watanabe	YMOR-236A	8201

TITLE OF INVENTION: DISK DEVICE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$300	\$1700	08/19/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above.

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

EXHIBIT A

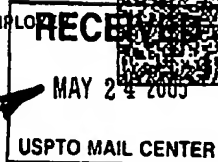
TC 2600

KNOX

Organization _____ Bldg./Room _____
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
Alexandria, VA. 22313-1450
If Undeliverable Return In Ten Days

Official Business
Penalty For Private Use, \$300

AN EQUAL OPPORTUNITY EMPLOYER



UNITED STATES POSTAGE
02 1A \$ 00.370
0004204055 MAY 19 2005
MAILED FROM ZIP CODE 22314

201 NI 1 403 C 08 08/21/05
NOTIFY SENDER OF NEW ADDRESS
PARKHURST & WENDEL LLP
PO BOX 20249
ALEXANDRIA VA 22320-1249
BC: 22320124949 *0217-08331-19-38

22314 223201249

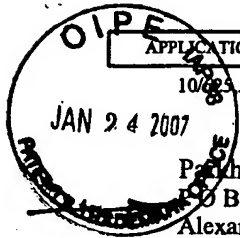


EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov



APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,542	07/24/2003	Masashi Watanabe	YMOR:236A	8201
7590 11/03/2005				
Pat. Hurst & Wendel LLP				
P.O. Box 20249				
Alexandria, VA 22320-1249				
RECEIVED NOV 0 2005				
STATIONER				
EXAMINER				
TUPPER, ROBERT S				
ART UNIT		PAPER NUMBER		
2652				

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EXHIBIT C

Date: 2/3/06
Action Due: Fees Due

IN

Notice of Allowability

Application No.

10/625,542

Examiner

Robert S. Tupper

Applicant(s)

WATANABE ET AL.

Art Unit

2652

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address—
claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included
rewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS
NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative
of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

☒ This communication is responsive to the amendment of 11/22/04.

☒ The allowed claim(s) is/are 17,20,21,24 and 26.

☒ The drawings filed on 24 July 2003 are accepted by the Examiner.

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 10/048583.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the
International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements
noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF
INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.

(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of
Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of
each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the
attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

☐ Notice of References Cited (PTO-892)

☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____

☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____

7. ☐ Examiner's Amendment/Comment

8. ☐ Examiner's Statement of Reasons for Allowance

9. ☐ Other _____

R.S. Tupper
Robert S Tupper
Primary Examiner
Art Unit 2652

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

7590 05/19/2005

PARKHURST & WENDEL, L.L.P.
1421 PRINCE STREET
SUITE 210
ALEXANDRIA, VA 22314-2805

NOV 0 2005

STEPTOE & JOHNSON, LLP

EXAMINER

TUPPER, ROBERT S

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 05/19/2005

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,542	07/24/2003	Masashi Watanabe	YMOR:236A	8201

TITLE OF INVENTION: DISK DEVICE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$300	\$1700	08/19/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

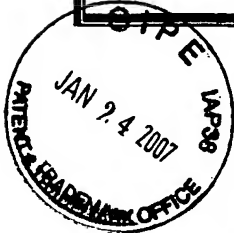
● PRINTER RUSH ●
(PTO ASSISTANCE)

51
HC

Application: 10/1025542 Examiner: Tupper GAU: 2652

From: LED CA Location: IDC FMF FDC Date: 11/28/05

Tracking #: _____ Week Date: _____



DOC CODE	DOC DATE	MISCELLANEOUS
<input type="checkbox"/> 1449	_____	<input type="checkbox"/> Continuing Data
<input type="checkbox"/> IDS	_____	<input type="checkbox"/> Foreign Priority
<input type="checkbox"/> CLM	_____	<input type="checkbox"/> Document Legibility
<input type="checkbox"/> IIFW	_____	<input type="checkbox"/> Fees
<input type="checkbox"/> SRFW	_____	<input checked="" type="checkbox"/> Other (NOA)
<input type="checkbox"/> DRW	_____	
<input type="checkbox"/> OATH	_____	
<input type="checkbox"/> 312	_____	
<input type="checkbox"/> SPEC	_____	

[RUSH] MESSAGE:

① NOA - In response to returned
NOA only a PTO L-37 was mailed out.
Please mail out a new PTO L-85
Thank you
LED

[XRUSH] RESPONSE:

INITIALS:

NOTE: This form will be included as part of the official USPTO record, with the Response document coded as XRUSH.

REV 10/04

EXHIBIT D

● PRINTER RUSH ●
(PTO ASSISTANCE)

SF
HC

Application: <u>10/125542</u>	Examiner: <u>Tupper</u>	GAU: <u>2652</u>
From: <u>LED</u> <u>CA</u>	Location: IDC <u>FMF</u> FDC <u>PC</u>	Date: <u>11/28/05</u>

Tracking #: _____ Week Date: _____

DOC CODE	DOC DATE	MISCELLANEOUS
<input type="checkbox"/> 1449	_____	<input type="checkbox"/> Continuing Data
<input type="checkbox"/> IDS	_____	<input type="checkbox"/> Foreign Priority
<input type="checkbox"/> CLM	_____	<input type="checkbox"/> Document Legibility
<input type="checkbox"/> IIFW	_____	<input type="checkbox"/> Fees
<input type="checkbox"/> SRFW	_____	<input checked="" type="checkbox"/> Other (NOA)
<input type="checkbox"/> DRW	_____	
<input type="checkbox"/> OATH	_____	
<input type="checkbox"/> 312	_____	
<input type="checkbox"/> SPEC	_____	

[RUSH] MESSAGE: _____

① NOA - In response to returned
NOA only a PTOL-37 was mailed out.
Please mail out a new PTOL-85
Thank you
LED

[XRUSH] RESPONSE: _____

NO EXAMINER ACTION REQUIRED
A PTOL-85 WAS REMAILED 12/8/05
RST
INITIALS:

NOTE: This form will be included as part of the official USPTO record, with the Response document coded as XRUSH.
REV 10/04

PRINTER RUSH
(PTO ASSISTANCE)

ST
NC

Application : 10/625,542 Examiner : Tupper GAU : 2652
From : CLD / (A) Location : IDC FMF FDC Date : 12/30/05

Tracking #:

Week Date:

Second Request

DOC CODE	DOC DATE	MISCELLANEOUS
<input type="checkbox"/> 1449	_____	<input type="checkbox"/> Continuing Data
<input type="checkbox"/> IDS	_____	<input type="checkbox"/> Foreign Priority
<input type="checkbox"/> CLM	_____	<input type="checkbox"/> Document Legibility
<input type="checkbox"/> IIFW	_____	<input type="checkbox"/> Fees
<input type="checkbox"/> SRFW	_____	<input checked="" type="checkbox"/> Other (NOA)
<input type="checkbox"/> DRW	_____	
<input type="checkbox"/> OATH	_____	
<input type="checkbox"/> 312	_____	
<input type="checkbox"/> SPEC	_____	

[RUSH] MESSAGE:

① NOA - In response to returned NOA only a PTOL-37 was mailed out. Please mail out a new PTOL-85. What was received 12/8/5 was the old PTOL-85 (fee is late without new NOA) / (A)

[XRUSH] RESPONSE:

INITIALS:

NOTE: This form will be included as part of the official USPTO record, with the Response document coded as XRUSH.

REV 10/04



Atty. Dkt. 28951.5236/D1
Serial No. 10/625,542
Applicant: M. WATANABE et al
Date: Decmeber 8, 2005

The Patent and Trademark Office date stamped hereon is acknowledgment that the following items were received by the PTO on the date stamped:

1. Fee(s) Transmittal w/\$1700 check No. 407044
2. Notice of Change of Correspondence Address
3. Return receipt postcard

DJ/due 2/3/06

DOCKETED

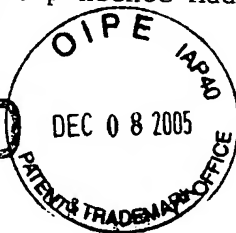


EXHIBIT E

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail**

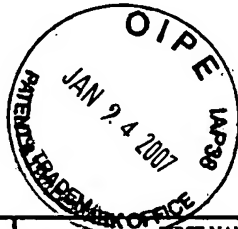
**Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or Fax (703) 746-4000**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

6160 7590 05/19/2005

**PARKHURST & WENDEL, L.L.P.
1421 PRINCE STREET
SUITE 210
ALEXANDRIA, VA 22314-2805**



Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (703) 746-4000, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/625,542 07/24/2003 Masashi Watanabe ~~VMOR-236A~~ 8201

28951.5236/D1

TITLE OF INVENTION: DISK DEVICE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
-------------	--------------	-----------	-----------------	------------------	----------

nonprovisional NO \$1400 \$300 \$1700 08/19/2005
02/03/06

EXAMINER	ART UNIT	CLASS-SUBCLASS
----------	----------	----------------

TUPPER, ROBERT S 2652 360-264700

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.563).

- ☒ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 STEPTOE & JOHNSON LLP

2
3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD. Kadoma-shi, Japan

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

- ☒ Issue Fee
☒ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies

4b. Payment of Fee(s):

- ☒ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☒ The Director is hereby authorized to charge the required fee(s), or credit any overpayment, to Deposit Account Number 19-4293 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature Roger W. Parkhurst

Date December 8, 2005

Typed or printed name Roger W. Parkhurst

Registration No. 25,177

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STEPTOE & JOHNSON LLP

VENDOR #		VENDOR NAME			CHECK #	CHECK DATE
11398		DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE			407044	12/07/2005
VOUCHER #	INV DATE	INVOICE #	COMMENTS	GROSS	DISCOUNT	AMOUNT PAID
517931	12/07/2005	1139812072005B	Issue Fee (28951.5236)	1,700.00	0.00	1,700.00
<p style="text-align: center;"> <u>COPY OF</u> <u>CHECK STUB</u> <u>NOT</u> <u>NEGOTIABLE</u> </p>						
CUSTOMER REF#				CHECK TOTALS	1,700.00	0.00
						1,700.00

NEW ATTY. DKT. 28951.5236/D1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Serial No.: 10/625,542

Confirmation No.: 8201

In re Application of

Group Art Unit: 2652

WATANABE et al.

Examiner: R. Tupper

Filed: July 24, 2003

For: DISK DEVICE

NOTICE OF CHANGE OF CORRESPONDENCE ADDRESS

US Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

Please forward all future correspondence in connection with the above-identified application to the undersigned attorney of record at the following new address:

CUSTOMER No. 53067

STEPTOE & JOHNSON LLP
1330 Connecticut Avenue, N.W.
Washington, D.C. 20036
Telephone: (202) 429-3000
Telefax: (202) 429-3902

Respectfully submitted,

Roger W. Parkhurst
Reg. No. 25,177



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,542	07/24/2003	Masashi Watanabe	YMOR:236A	8201

7590 01/30/2006
STEPTOE & JOHNSON LLP
1330 Connecticut Ave, N.W.
Washington, DC 20036

RECEIVED

FEB 6 2006

STEPTOE & JOHNSON, LLP

EXAMINER

TUPPER, ROBERT S

ART UNIT PAPER NUMBER

2652

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

EXHIBIT F

Notice of Abandonment

Application No.

10/625,542

Applicant(s)

WATANABE

Examiner

Art Unit

TUPPER

2652

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☒ The issue fee and publication fee, if applicable, was received on 12/08/05 (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

lgd

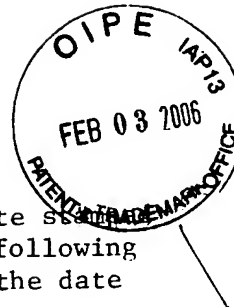
Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



Atty. Dkt. 28951.5236/D1

Applicant: M. WATANABE et al
Serial No. 10/625,542

Date: February 3, 2006



The Patent and Trademark Office date stamp hereon is acknowledgment that the following items were received by the PTO on the date stamped:

1. Request for Recission of Notice of Abandonment w/copy of communication mailed November 3, 2005 including copy of Notices mailed May 19, 2005
2. Return receipt postcard

DJ

DOCKETED

EXHIBIT G

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 10/625,542

Confirmation No. 8201

In re the Application of

WATANABE et al

Group Art Unit 2652

Filed: July 24, 2003

Examiner Robert S. Tupper

For: DISK DEVICE

Allowed: May 19, 2005 (remailed November 3, 2005)

REQUEST FOR RECISSION OF NOTICE OF ABANDONMENT

U.S. Patent & Trademark Office
Customer Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

It is hereby requested that the Notice of Abandonment mailed January 30, 2006 be rescinded.

A Notice of Allowance and Notice of Allowability were mailed May 19, 2005 to the undersigned attorneys' previous address, but, for reasons unknown, was not forwarded to the new address by the postal service. Thus, the original of the Notices was never received by the attorneys of record. Upon inquiry, the Notices were remailed by the USPTO on November 3, 2005 to the new address of the attorneys of record. A copy of the November 3, 2005 communication is attached.

The remailing of the Notice of Allowance on November 3, 2005 restarted the period for payment of the fees, the new due date for which was February 3, 2006. Thus, payment of the fees on December 8, 2005 is timely.

In view of the foregoing, and the timely payment of the fees due, it is hereby respectfully requested that the Notice of Abandonment be rescinded and the application proceed to issue.

Respectfully submitted,

STEPTOE & JOHNSON LLP


Charles A. Wendel

Reg. No. 24,453

1330 Connecticut Ave., NW
Washington, DC 20036
Tel: 202-429-3000

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☒ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.